



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487

29471 7590 02/16/2005

MCCRACKEN & FRANK LLP  
200 W. ADAMS STREET  
SUITE 2150  
CHICAGO, IL 60606

EXAMINER
----------

PAULA, CESAR B

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/388,191	DREYER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CESAR B. PAULA	2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/04</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2178

### **DETAILED ACTION**

1. This action is responsive to the amendment, and IDS filed on 6/28, and 8/20/2004 respectively.

**This action is made Final.**

2. In the amendment, claims 1-26 are pending in the case. Claims 1, and 16 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 6/28/2004 has been considered by the examiner, except for the Non-Patent literature, because it has been filed without copies.

### ***Drawings***

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Double Patenting***

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) has been filed to overcome the obviousness-type double patenting rejection. Therefore the rejections of claims 1-26 have been withdrawn.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-9, 11-21, and 24-26 remain rejected under 35 U.S.C. 102(b) as being anticipated by Simpson, A., hereinafter Simpson, Sybex, 1993, pp.539-579, 852-859.

Regarding independent claim 1, Simpson discloses using Wordperfect for the conversion of an ASCII comma-delimited text (csv) file—*first page description file--* (fig.25.3) into a Wordperfect formatted secondary merge file, which contains part of the data in the csv file plus additional formatting data (fig.25.4). The secondary merge file—*first page description file--* contains records and fields to be inserted or merged into a primary merge file to produce a third document —*second page description file* (pages 855, 540, lines 1-30).

Moreover, Simpson teaches using Wordperfect for the creation of a primary merge file—*template--* having commands telling Wordperfect exactly where to place variable text (page 553).

In addition, Simpson discloses using Wordperfect for the conversion of the csv file—*first page description file--* (fig.25.3) into a Wordperfect formatted secondary merge file—*database for storing the data indicative of the portions of the first page description file--*, which contains part of the data in the csv file plus additional formatting data—*extraction of data from the first page description file* (fig.25.4, page 855).

Art Unit: 2178

Furthermore, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*-- to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4).

Regarding claim 2, which depends on claim 1, Simpson discloses generating a primary merge file—*template*—with commands or placeholders for indicating location where variable information is to be placed (page 540, lines 7-30, fig. 16.1).

Regarding claim 3, which depends on claim 2, Simpson discloses an Wordperfect —*page make-up application program*-- for generating the primary merge file—*template*—with commands or placeholders for indicating location in the primary merge file where variable information is to be placed (pages 539, 540, lines 7-30, fig. 16.1).

Regarding claim 5, which depends on claim 1, Simpson teaches using Wordperfect for the creation of a primary merge file—*template*-- having commands telling Wordperfect exactly where to place variable text extracted from the data found in the csv file—*first page description file*-- (page 553, 855, fig. 25.3-4).

Regarding claim 6, which depends on claim 1, Simpson discloses using Wordperfect for the conversion of the csv file—*first page description file*-- (fig.25.3) into a Wordperfect formatted secondary merge file—*database*--, which contains a plurality of Wordperfect

Art Unit: 2178

formatted fields with the data found in the csv file—*characterizing each portion of the portions of the first page description file* (fig.25.3-4, page 855).

Regarding claim 7, which depends on claim 1, Simpson discloses the conversion of a plurality of data records, fields and respective format —*first data portion and second data portion--* from csv format to Wordperfect format, which contains the fields, and records separated from each other within a file (page 855, fig.25.3-4).

Regarding claim 8, which depends on claim 7, Simpson discloses the storage of a csv file, which contains data separated by commas and “CR/LF” commands—*content and control data--* (page 855, fig.25.3).

Regarding claim 9, which depends on claim 8, Simpson discloses the conversion of a plurality of data records, fields and respective format from csv format to Wordperfect format using a “File Open” menu on a gui of the application (page 855, fig.25.3-4).

Regarding claim 11, which depends on claim 1, Simpson discloses the merging of two files, a primary merge file, such as form letters, mailing label, packing slip, etc.—*templates--* A secondary merge file—*database*—containing records indicating information to be inserted into the primary merge files (page 540, lines 1-30, fig.25.3).

Art Unit: 2178

Regarding claim 12, which depends on claim 1, Simpson discloses the storage of a csv file —*image file*--, which contains data, such as “date, expense, amount...” —*image elements*-- which are displayed as font image on a computer screen separated by commas and “CR/LF” commands (page 855, fig.25.3).

Regarding claim 13, which depends on claim 12, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4).

Regarding claim 14, which depends on claim 1, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). In other words, the data in the secondary merge file is transferred to the primary merge file—*modifying the data stored in the database*-- and then a third file is produced after the transfer. The data in the secondary merge file is no longer located just in the database.

Claim 15 is directed towards a software system for implementing the software found in claim 14, and therefore is similarly rejected.

Art Unit: 2178

Claims 16-21, 24-26 are directed towards a method for implementing the system found in claims 1, 3, 5-8, 11-12, and 14 respectively, and therefore are similarly rejected.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson.

Regarding claim 4, which depends on claim 1, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). Simpson fails to explicitly disclose: *page make-up software application comprises QuarkXPress*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included QuarkXPress, because Simpson teaches the automatic printing of personalized documents using a basic list of names and addresses which can be used over and over. Thus, providing the benefit of printing personalized document as often as a user needs without ever retyping a single name or address using an application such as *QuarkXPress*.



Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

10. Claims 10, and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen, in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Simpson discloses the merging of two files, a primary merge file, such as form letters, mailing label, packing slip, etc.—*templates*-- A secondary merge file containing records indicating information to be inserted into the primary merge files (page 540, lines 1-30, fig.25.3). Cohen fails to explicitly disclose: *plurality of pages to be printed in a book*. However, Mastie teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Simpson, and Mastie, because Mastie teaches above the creation of a book onto a single document which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10, and therefore is similarly rejected.

***Response to Arguments***

Art Unit: 2178

11. Applicant's arguments filed 6/28/2004 have been fully considered but they are not persuasive. Regarding claim 1, the Applicants indicate that none of the prior art teaches or suggests a software system for generating a second page description file from a first page description file including a routine for extracting data from a first page description file for generating a database (page 7, lines 17-20). The Examiner disagrees, because Simpson teaches using a csv file to produce a document through some intermediate steps (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "As described in the specification of the present application of the present application, a page description file is a page mark-up or layout file, such as a Quarkxpress® file, an HTML file, an Acrobat® PDF file, or any other type of file that comprises content and layout information for one or more pages to be printed, displayed, or otherwise distributed" page 7, line 30-page 8, line 1) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, the Applicants note that Simpson doesn't extract data from a first page description file to generate a database. Instead, Simpson extracts data from a first database formatted in a first manner to create a second database formatted in a second manner (page 8, lines 1-4). The first database is not just a database. It is also a file in a comma-delimited format. This file contains data, which describes how the file is to be displayed—*page description file*. In

Art Unit: 2178

other words, the file indicates the order categories of information are to be displayed—Date, Expense, etc.--in a screen

Claims 2-26 are rejected at least based on the rationale set forth above.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Application/Control Number: 09/388,191

Page 11

Art Unit: 2178

Any response to this Action should be mailed to:

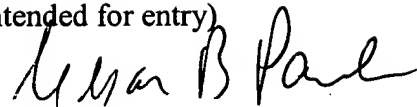
Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (703) 703-872-9306, (for all Formal communications intended for entry)



CESAR B PAULA

PRIMARY EXAMINER

AU 2178

2/15/05